REMARKS/ARGUMENTS

Claims 18-23 and 49-53 are currently pending in this application and claims 11-17 are withdrawn from consideration. Claims 21, 50 and 52 have been amended. In view of the above amendments and following remarks, Applicant respectfully submits that the application is in condition for allowance. Applicant therefore, respectfully requests reconsideration and allowance of the application.

Claims 50 and 52 are objected to because of informalities. In view of the amendments to claims 50 and 52, it is respectfully requested that the above objections be withdrawn.

Claims 18 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. More specifically, it is alleged that the steps of "selecting an [validated in claim 49] address from the results," and "printing the selected [validated in claim 49] address on the VB1."

Applicant respectfully submits that the above rejections are improperly expressed and that the Examiner is engaging in improper piecemeal examination. MPEP 707.07(g) states that "piecemeal examination should be avoided as much as possible. The Examiner should reject each claim on all valid grounds available." The language of "printing the selected [validated in claim 49] address on the VB1" in claims 18 and 49 were added to the respective claims in an amendment dated April 23, 2004, which was in response to the Office action dated December 23, 2003. Since then, four Office actions have been issued (respectively dated 7/8/04, 3/11/05, 7/25/05, and 11/14/06), none of which, except the current Office action addressed the above 112, first paragraph rejections.

Furthermore, as evidence of (improper) piecemeal examination, an Election Restriction was issued on 11/18/02, as the first Office action grouping claims 11-23 in a same invention group. There were four substantive Office actions issued rejecting the group including claims 11-23, as part of the same invention, based on prior art. However, in another Election Restriction issued on 7/25/05, suddenly, it was required to elect either claims 11-17, or claims 18-23 (and newly added claims 49-53). In order to expedite the prosecution of this application,

Applicant elected the second group for examination. However, the Examiner had ample missed opportunities to require election of the above two groups, in prior Office actions.

Nevertheless, Applicant addresses the above 112, first paragraph rejections as follow and respectfully request that the Examiner put an end to this improper piecemeal examination practice.

With respect to "selecting an address from the results," this language has plenty of support through out the specification. For example, block 44 in FIG. 2 clearly supports that the "user selects from multiple potential matches." The specification also clearly states that "The results are preferably presented to the user as a list, such as the list shown in FIG. 11," (See, page 9, 25-26) and "then operation proceeds to step 44, and the sender selects one of the potential addresses." (See, page 10, 13-14). Additionally, FIG. 11 depicts a GU1. The banner on top of the GU1 includes the language of "Please choose a more specific address from the list provided below." The middle part of the GU1 then shows a highlighted address, as the selected address.

With respect to "printing the selected address on the VB1," the specification stresses that "One of the standards required by the USPS is that the address of the intended recipient of a piece of mail be verified by comparing the entered address with a database of valid addresses provided by the USPS." (Page 2, lines 8-11). The specification also describes "Operation begins at step 30, with a sender entering a destination address for a corresponding piece of mail into the associated client 16. FIG. 10 shows a suitable user interface 21 that client 16 may present to user for input of the pertinent shipping information. User interface 21 includes a pair of windows 22 into which the user may enter delivery and return addresses in a free form (i.e., without separating the address information into multiple fields). The user interface 21 also includes a number of windows 23 into which the user may enter postage information, as is well known in the art." (Page 8, lines 22-31.). The GU1 of FIG. 10 depict its name as "Print Postage" on the top left and includes a "Print Postage" button at the bottom. It is well known in the art that that "Print Postage" button of the FIG. 10 "Print Postage" GU1 will print the indicated addresses and the postage on the indicated mailpiece, as depicted in the "Layout Preview" section of the FIG. 10 "Print Postage" GU1.

Furthermore, referring to FIG. 2, the specification explains that "the matched address may then be used by the client 16 in a postage meter procedure," and "AMS server 12 processes the request, and transmits all necessary information relating to the single address to client 16, which may then use the address in a postage meter procedure." (page 10, lines 10-11 and 17-19.) One skilled in the art would readily appreciate that a "postage meter procedure" includes printing a generated postage and an address on a mailpiece.

As a result, the above language of claims 18 and 49 are fully supported by the specification and therefore it is respectfully requested the above rejection be withdrawn.

Claims 18-20 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jatkowski (US 6,457,012) in view of Gardner et al. (US 6,701,352).

In view of the following remarks, Applicant again respectfully submits that the application is in condition for allowance, therefore, reconsideration and allowance of the application are respectfully requested.

Amended independent claim 18 includes, among other limitations, "storing a plurality of pre-approved addresses with a predetermined format in the database;" "mapping the received address data with the different formats into the predetermined format;" "displaying the results for selection by a user, if one or more matches are found;" and "selecting an address from the results."

The Jatkowski/Gardner combination does not suggest the above recited limitations.

First, with regard to the limitation of "storing a plurality of pre-approved addresses with a predetermined format in the database," Applicant respectfully disagrees with the assertion in the Office action that the NCOA database 28 teaches this limitation. There is no teaching in Jatkowski that the addresses stored in the NCOA database are "pre-approved addresses" and have "a predetermined format." Jatkowski is very clear about reformatting the address data request for compatibility of different systems, and not the address data itself. For example, Jatkowski emphasizes that "the request is transmitted from the client to an application host system such as ForwardTrak. The address data request is translated at the application host system into a format readable by a master system comprising change of address files. In order for the

translated request to be transmitted from the application host system to the master system, there must be created an interface that allows passage of the translated address data request from the application host system to master system so that said translated address data request can be read and responded to by the master system. The interface is created during the method's translation step. The translation step comprises a number of further steps that begin with creating a data map of the data representative of the address data **request**. The created data map is compared against a second set of data representative of a mailing list correction (MLC) scheme, or a multi-line optical character reader (MLOCR) scheme. The comparison establishes a second data map which is representative of the address request in either the MLC or the MLOCR scheme. The second data map is then transmitted via a SCSI interface to the master system for processing of the address request. (Col. 2, lines 46-67, underlining is added; see also, col. 4, lines 54-59.).

Additionally, Jatkowski makes it clear that "Once the data is entered, the system queries at step 104 as to whether or not the entered data is in a pre-parsed zip+4 format. If the response to the query is "YES," then the system advances to step 106 where the address data request is sent to the batch driver . . . if the response to the query is "NO," then the method advances to a query at step 108 which asks whether or not the data is unparsed and in a non-zip+4 format. If the response to the query is "NO," then the system advances to step 110 where the address data request is rejected and the system turns to a query at step 112. At step 112, the method queries as to whether or not there is a next address data request.: (Col. 5, lines 40-55, underlining added.). This makes it clear that there is no reformatting of the address data rather, it is the address request (command) that is being reformatted to match the MLC or MLOCR schemes.

Therefore, there is no teaching in Jatkowski about "storing a plurality of addresses with a predetermined format." As the Examiner agrees, Gardner does not cure the above deficiency of Jatkowski.

Second, Jatkowski does not disclose that the stored addresses are "pre-approved addresses." Rather, the National Change of Address Database, or NCOA of Jatkowski is simply a "series of move updates that effect address databases. . . . Under the new standards, companies are required to show that they are implementing a process to track a customer's change of

address." (Col. 1, lines 47-56). Moreover, Jatkowski stresses that "the purpose of the address record request is to determine whether the <u>addressee has indicated a change of address</u> to a master application such as the National Change of Address (NCOA) database." Although the addresses in the NCOA may be more up-to-date, they are not "pre-approved." As the Examiner agrees, Gardner does not cure the above deficiency of Jatkowski.

Third, with regard to the limitation of "mapping the received address data with the different formats into the predetermined format," as explained above, no mapping of the address <u>data</u> is performed in Jatkowski. As the Examiner agrees, Gardner does not cure the above deficiency of Jatkowski.

Fourth, with regard to the limitation of "displaying the results for selection by a user, if one or more matches are found," and "selecting an address from the results," the Examiner agrees that Jatkowski does not teach or suggest this limitation. However, the Examiner cites to Gardner for teaching the above limitation. Applicant respectfully disagrees. Gardner is about importing mailing list according to pre-defined selection criteria for printing labels. (See, for example, the Abstract.). "The user <u>queries</u> the database using <u>selection criteria that specify a range</u> of <u>addresses within the database</u>, such as <u>businesses involved in a particular field</u> or market. Using <u>pre-defined instructions</u>, the user can instruct the mailing list manager to create a copy of a form document for each of the selected addressees and to insert the addressee's address into the form document. The user can then instruct the mailing list manager to print each <u>customized document</u>. (Col. 5, lines 46-54, underlining added.). This stated "range of <u>addresses within the database</u>" refers to the <u>location of the records</u> in the database, and <u>not mailing addresses</u>, as claimed.

Furthermore, Gardner explains that "Customized documents for printing and mailing are generated using the mailing list manager 206 with the imported information. The mailing list manager 206 may be used to modify the imported information or to <u>select a range of records</u> from the imported information." (Col. 13, lines 1-3, underlining added.). This selection of range of records" does not teach or suggest "displaying the results [i.e, matched mailing addresses] for selection by a user," and "selecting an address from the results," because there is no mention of

displaying the records so that a user can select a record. The list manager 206 is simply used to specify a range, for example, <u>businesses involved in a particular field</u> (col. 5, lines 48-49) so that a list of all the book stores within an area can be compiled and printed on labels. Moreover, the "records" of Gardner, although may or may not include mailing addresses, are primarily business names and types, and not merely a list of mailing addresses.

Consequently, Gardner does not teach or suggest "displaying the results [i.e, matched mailing addresses] for selection by a user."

Accordingly, claim 18 is patentable in view of the cited references. Therefore allowance of claim 18 is respectfully requested. Dependent claims 19-23 depend directly or indirectly from claim 18 and include all of the limitations of claim 18. Therefore these claims are also allowable as is claim 18, and for additional limitations recited therein.
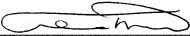
Amended independent claim 49 includes, among other limitations, "storing a plurality of pre-approved addresses in a database;" "comparing the address received from the remote terminal to the database of pre-approved addresses;" "displaying the results on the remote terminal;" and "selecting a validated address from the displayed results." As discussed above, with respect to claim 18, none of the cited references, alone or in combination, teach or suggest the above limitation. Consequently, Applicant respectfully submits that independent claim 49 recites a novel and unobvious method over the cited references and is therefore allowable. Applicant further submits that claims 50-53, that depend directly or indirectly from claim 49 are allowable as is claim 49 and for additional limitations recited therein.

In view of the foregoing remarks and for at least above-mentioned **four reasons**, it is respectfully submitted that this application is now in condition for allowance, and accordingly, reconsideration and allowance are respectfully requested.

Applicant respectfully brings to Examiner's attention the fact that the current Office action is the **eighth (8th) Office action** for this case and therefore Applicant respectfully encourages the Examiner to contact the undersigned for any questions that the Examiner may have to expedite the prosecution of this application.

Respectfully submitted,

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